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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/332,298	06/11/1999	YASUSHI ABE	31812	2750

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EXAMINER

NGUYEN, NAM V ,

ART UNIT	PAPER NUMBER
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2635

DATE MAILED: 09/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/332,298

Applicant(s)

ABE, YASUSHI

Examiner

Nam V Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 August 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-24 is/are allowed.
- 6) ☒ Claim(s) 25-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### **DETAILED ACTION**

This communication is in response to applicant's response to Response "D" which is filed August 11, 2003.

Claims 1-28 are pending.

### ***Response to Arguments***

Applicant's argument and amendment with respect to the pending claims 7, 11 and 21, filed August 11, 2003, are persuasive. Therefore the examiner has withdrawn the rejections.

Applicant's arguments to the rejected claim 25 is insufficient to distinguish the claimed invention from the cited prior arts or overcome the rejection of said claims under 35 U.S.C § 103(a) as discussed below. Applicant's arguments have been fully considered but they are not persuasive for at least the following reasons.

Regarding claim 25, on page 18, third paragraph, Applicant's arguments that Vanden Heuvel in view of Helferich and in further view of Murai does not teach or suggest every limitation of the claims.

Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The

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test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971).

Vanden Heuvel suggests that when a valid message received and it is a personal selective call message, the memory manager checks for an available memory slot. If no slot is available, the oldest read or oldest unread message is deleted and the next available personal control area slot is made available for message storage. This method would ensure effective utilization of the memory data area (column 9 lines 55 to column 10 lines 9; see Figure 9). Helferich teaches that erasing the messages after the messages have been checked by the user selection function.

The pager transceiver of Helferich teaches that when a valid message received a selective call, the pager transceiver CPU determine whether an acknowledgment has been enabled. If the acknowledgment has been enabled, the acknowledgment flag is enabled (column 9 lines 58 to 67; see Figure 7). The pager transceiver CPU performs house keeping functions (column 10 lines 1 to 18). The user selects the functions to be performed from available functions such as retrieve, erase or save message (column 10 lines 19 to 30; see Figure 8). One of ordinary skilled in the art understand that a user select an erase function after the received message is read, the received message is marked in order for the pager transceiver CPU knows that a particular message is erased after the process function is performed. Therefore, Helferich teaches or suggests deleting a message once it is checked by the user.

Murai teaches or suggests that the radio telecommunication apparatus capable of storing received messages and erasing the messages at programmable intervals. The radio telecommunication apparatus includes a second input section for inputting data representing the timings of erasing the messages stored in the memory circuit. Second, the message-erasing

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circuit erases messages from the memory circuit in accordance with the time data output by the timer circuit and also with the message-erasing timing data input by operating the second input section. With this device it is possible to erase the messages sequentially in the order they have been received, or in ascending order of importance (column 3 lines 42 to 55; see Figure 1). The radio telecommunication apparatus further includes a display and a display control circuit. The display control circuit reads the messages from the memory circuit and causes the display to display the messages, before the second input circuit is operated to set and hold message-erasing data items representing timings of erasing the messages stored in the memory circuit. Hence, immediately after the holder of the device operates the second input section, thus inputting the timing of erasing any message from the message circuit, he or she can see the message on the display and confirm which message he or she is going to erase (column 3 line 56 to column 4 line 2).

Therefore, Vanden Heuvel in view of Helferich and in further view of Murai does teach or suggest every limitation of the claims. The examiner maintains that the references cited and applied in the last office actions for the rejection of the claims are maintained in this office action.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vanden Heuvel et al. (US# 5426,424) in view of Helferich (US# 6,259,892).

Referring to claim 25, Vanden Heuvel et al. disclose a message erasing method comprising the steps of:

Receiving a radio signal from a base station of a radio paging system (column 1 lines 11 to 15; see Figure 1);

Picking up one calling address or a plurality of calling addresses assigned to own receiver from the radio signal being received (column 4 lines 26 to 33);

Picking up message data corresponding to the calling address or the calling addresses (column 4 lines 48 to 52);

Storing the message data picked up (column 4 lines 48 to 52);

Designating character sequences in stored messages (column 5 lines 60 to 63);

Detecting whether or not designated character sequences are contained in stored messages (column 5 lines 63 to 66); and

However, Vanden Heuvel et al. did not explicitly disclose that erasing concerned messages collectively when designated character sequences are contained in the stored messages. Vanden Heuvel et al. disclose erasing designated data bases upon receiving an add/delete selective call message (column 9 lines 65 to 68).

In the same field of endeavor of radio paging receiver, Helferich teaches that the erasing means (116; see Figures 8 and 9) to erase concerned messages (201; see Figure 11) when it is detected by the character sequence retrieving means (114) (column 12 lines 55 to 65; column 13

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lines 1 to 17) that the designated character sequences (i.e. message identifier of 201) are contained in the stored messages (5) and it is detected by the time counting means (28) that the predetermined time has lapsed after the messages (201) are stored (column 11 lines 35 to 48; column 13 lines 17 to 28; column 13 lines 62 to column 14 lines 23) in order to erase the message resided in memory for a certain period of time by using the retrieving message function to retrieve all the message in data message memory with a message identifier that the user was mark.

One skill in the art would have recognized to erase concerned messages when it is detected by retrieve message function that a predetermined time has lapsed of Helferich to erasing designated data bases upon receiving an add/delete selective call message of Vanden Heuvel et al. because Vanden Heuvel et al. suggest that the need to modify a time that set by a user to delete old messages in the memory is so desired (column 8 lines 42 to 63) and Helferich teaches that the user to program the paging transceiver to erase messages by retrieving all messages with a message identifier of a data message at a particular time or set a expire time (column 3 lines 27 to 41; column 10 lines 36 to 44; column 11 lines 35 to 48). Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to erase concerned messages when it is detected by message identifier that a predetermined time has lapsed of Helferich in erasing designated data bases upon receiving an add/delete selective call message as evidenced by Vanden Heuvel et al. with the motivation being to provide a radio pager transceiver capable of erasing the messages at programmable intervals that is set by users to save the memory space.

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Claims 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vanden Heuvel et al. (US# 5426,424) in view of Helferich (US# 6,259,892) and further in view of Murai (US# 5,239,679.)

Referring to claims 26-28, Vanden Heuvel et al. in view of Helferich disclose a radio paging receiver according to claim 25 above. However, Vanden Heuvel in view of Helferich did not clearly disclose wherein the messages are erased collectively concerned messages.

In the same field of endeavor of selective call receiver, Murai teaches that the messages are erased collectively concerned messages (column 3 lines 43 to 55) for the purpose of erasing the selectively stored messages.

One skill in the art would have recognized the need to modify the way to erase the messages in memory selectively by using the input section of Murai to the selective call receiver of Vanden Heuvel et al. in view of Helferich because Vanden Heuvel et al. suggests that the need to erase the messages in memory selectively is so desired and Murai teaches that pager holder has preset the message-erasing time of "00:00," all message codes stored in the message memory, except for those containing a data-preserving flag, are automatically erased at the preset message-erasing time (column 10 lines 21 to 29). Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to modify the way to erase the messages in memory selectively by using the input section of Murai into the selective call receiver of Vanden Heuvel et al. in view of Helferich with the motivation that a selective call receiver capable of erasing the collectively concerned messages of the user choice and providing the memory has more space to store other messages.



***Allowable Subject Matter***

Claims 7-10 and 21-24 are allowed as evident by applicant's arguments.

Referring to claims 7 and 21, the following is a statement of reasons for the indication of allowable subject matter: the prior art fail to suggest limitations that wherein, when designated character sequences are contained in the received messages, the messages are not stored in a storage area but automatically erased after the messages have been checked.

Referring to claim 11, the following is a statement of reasons for the indication of allowable subject matter: the prior art fail to suggest limitations that stored character sequence retrieving means for detecting whether or not designated character sequences are contained in the message data picked up by the first decoding means stored in the data storing means; and erasing means for erasing the messages; wherein, when designated character sequences are contained in the stored messages, the messages are erased collectively concerned messages.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nam V Nguyen whose telephone number is 703-305-3867. The examiner can normally be reached on Mon-Fri, 8:00AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on 703-305-4704. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Nam Nguyen  
September 21, 2003



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